

## REMARKS/ARGUMENTS

As a preliminary matter, Applicants respectfully point out that, in the Office Action Summary, the Examiner has indicated that the pending action is non-final. However, on Page 41 of the pending office action, the Examiner states: "THIS ACTION IS MADE FINAL." Therefore, Applicants respectfully request the Examiner's clarification on the issue as to whether or not the pending office action of 21 August 2007 is indeed made final.

The amendments and remarks hereto attend to all outstanding issues in the pending office action of 21 August 2007. Claims 1, 3, 4, 6-30 and 43-72 remain pending before the following arguments. Claims 1, 14, 25, 43-63, 64, 66, 68 and 70-72 are hereby amended. New claims 77-105 are hereby added.

### Amendments to the Claims

Independent claims 1, 14, 25, 43, 44, 46 – 61, 64, 66, 68, 70 and 72 are amended to clarify that the e-mail message enhancement occurs after the e-mail message has been composed and sent via a standard messaging protocol. Such an amendment is supported in the application as filed, which repeatedly refers to "standard multi-user e-mail messaging systems" and the standard protocols used therein; for example, paragraph [0006] of the present application as filed states:

The primary technology for e-mail is the TCP/IP communication protocol known as Simple Mail Transfer Protocol (SMTP). SMTP is the fundamental technology used in mail transport agents (MTAs), which are applications that send, receive and route e-mail messages on mail servers. While e-mail was originally designed to support the delivery of text messages, subsequent development produced potential support for rich media e-mail messaging through the Multipurpose Internet Mail Extensions (MIME) standard, which allows transmission of messages in several parts, including a part containing HTML, the current coding language for rich media content on the Internet at the present time.

Furthermore, the processing and sending of the original e-mail message, prior to enhancement, is supported in the application as filed at, for example, paragraph [0079].

Additionally, independent claims 45 and 62 are amended to specify that the e-mail message is directed to a predetermined location *after* the e-mail message has been composed and sent from a Mail Transport Agent (MTA) via a standard messaging protocol. The meaning of "standard messaging protocol" was discussed in the previous paragraph. A MTA, in the context of the present disclosure, is understood to be applications that send, receive and route e-mail messages on mail servers as discussed in, for instance,

paragraph [0006] of the application as filed. Therefore, it is respectfully submitted that no new matter has been added by the aforescribed amendments.

New claims 77-105 have been added to clarify that the standard messaging protocol, as discussed above, may include Simple Mail Transfer Protocol, or SMTP for short. Moreover, new claim 78 specifies that, after being composed and sent via the standard messaging protocol, the e-mail cannot thereafter be modified by the originating user. This amendment is supported, for example, in paragraph [0079] of the application as filed, which describes the way in which all e-mail enhancements take place after the origination of the e-mail message without further action by the originating user. Therefore, Applicants respectfully submit that no new matter is added by these new claims. For these reasons, Applicants believe that new claims 77-105 overcome the art of record when viewed in a reasonable light.

## **REMARKS IN RESPONSE TO OFFICE ACTION**

The following paragraphs follow the order of the paragraphs in the Office Action mailed 21 August 2007 in this application.

Applicants acknowledge the Examiner's thorough consideration of the Applicants' previously presented arguments in the Response to Amendments/Arguments section of the pending office action. A major point of contention of the Examiner appears to be an accusation that the Applicants have "cherry pick[ed]" passages in the art of record while failing to "capture the essence of the teachings of the prior art reference" (Page 5, Office Action). Applicants respectfully submit that an attempt has been made to point out those paragraphs that are believed to contain the most specific descriptions relevant to the claims at hand. Particularly regarding passages cited in the §102 rejections, Applicants believe that even these passages are not sufficient to anticipate the combined limitations of the claims of the present application either explicitly or inherently based on the well-settled standard for anticipation, which requires that the reference identically disclose or require each and every feature of the claim.

Furthermore, it is respectfully submitted that Applicants had sincerely attempted to thoroughly address the passages as selected and cited by the Examiner in the office action of February 27, 2007. That is, as the Examiner repeatedly has cited a limited collection of passages from the art of record to reject a wide variety of claimed limitations in the pending claims of the present application, Applicants concentrated the rebuttal arguments on those few cited passages from the art of record. However, the art of record was considered in whole, and it is still the Applicants' belief that the art of record, singly or in combination, fails to anticipate the inventions as claimed in the present application. While the Examiner asserts that Applicants have attempted to select passages which present the reference in a light that is different from the claimed invention and compels Applicant to "capture the essence of the teachings of the prior art reference," Applicants believe that the most relevant and directly related teachings of the reference have been brought to

light by Applicants arguments in relation to the specific claim limitations at hand and that these teachings do not appear to be controverted by paying deference to the essence of the reference nor by any detailed discussions in the reference to which Applicants' attention has been directed. In other words, the Office appears to improperly pay deference to the teachings of the art of record as a whole in relation to specific claim limitations over and above the closest specific teachings of the reference. Accordingly, clarification is respectfully requested with respect to these issues in the event that the rejections are maintained. Therefore, Applicants respectfully request that the teachings in the art of record be considered within the specific standards of each type of claim rejection, as will be further discussed below.

### **Claim Rejections – 35 U.S.C. 102(e)**

Claims 1, 3, 4, 6-30 and 62-63 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,360,221 B1 to Gough et al. (hereinafter "Gough"). With respect to these claims, Applicants respectfully traverse this rejection at least in light of the amendments to independent claims 1, 25 and 62.

To anticipate a claim, Gough must teach every element of the claim and "the identical invention must be shown in as complete detail as is contained in the ... claim." Section 2131 of the MPEP (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987), and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989)). Applicants respectfully submit that Gough fails to satisfy this standard, as argued previously, and below.

Claim 1, as amended, recites:

In a multi-user e-mail messaging system interfaced through the Internet and including at least a first user group sharing at least a first server, which first server is, in turn, interfaced to the Internet such that any user of the first user group may compose an e-mail message for transfer to an intended recipient selected as at least one of another user in the first user group and a remote user interfaced to the Internet by a connection other than said first server, a method comprising:

after said e-mail message has been composed and sent via a standard messaging protocol by an originating user of the first user group, directing the e-mail message onto an e-mail enhancement path, including (i) receiving the e-mail message at said first server, (ii) altering the e-mail message, and (iii) directing the altered e-mail message to a second server located on the e-mail enhancement path;

adding additional rich media content to said e-mail message using the e-mail enhancement path to produce an enhanced e-mail message; and

thereafter, directing the enhanced e-mail message from the e-mail enhancement path to the intended recipient.

Applicants respectfully submit that the art of record does not teach every element of amended claim 1, as will be discussed in further detail immediately hereinafter.

At least one claim element that is not taught by the art of record is the limitation that the direction of the e-mail message onto an e-mail enhancement path and the addition of rich media content occurs “after said e-mail message has been composed and sent via a standard messaging protocol.” When taken as a whole, Applicants respectfully submit that nowhere in Gough is there a teaching of the e-mail enhancement AFTER composition and sending of the e-mail message by the originating user. As is clearly shown in FIG. 1 and described in the related text, a sender provides “message content” to a “website 11” by, assumedly, hyper text transfer protocol (HTTP) rather than a standard messaging protocol, which website “‘enhances’ the message content and *sends or ‘e-mails’ the message* to one or more recipient mail boxes” (Gough, column 4, lines 3 – 9; emphasis added). In other words, according to the teachings of Gough, the enhancement of the e-mail message takes place BEFORE the e-mail is directed to an intended recipient by an e-mail server. It is respectfully submitted that none of the excerpts of Gough cited by the Examiner (namely FIG. 1, abstract, column 18 lines 3-20, column 4 lines 1-21, FIG. 2B, column 6 lines 12-39, FIG. 3, column 7 lines 43-61 and column 3 lines 50-67) teaches the limitation of amended claim 1 that the direction of the e-mail message onto an e-mail enhancement path and the addition of rich media content occurs AFTER the e-mail message has been composed and sent via a standard messaging protocol.

In fact, even beyond these passages cited by the Examiner against pending amended claim 1, Gough teaches the creation and sending of the e-mail message only following the e-mail message enhancement. For example, Gough states that the invention disclosed relates to “e-mail systems utilizing an HTML format for delivery over a TCP/IP protocol network,” rather than e-mail messages sent via standard messaging protocol, such as SMTP. As another example, FIG. 9 of Gough refers to a “Format and Send Message” step 906, which involves the creation and sending of the enhanced email message in accordance with text data provided by a user, as illustrated in FIG. 11 and text associated therewith in column 14 lines 3 – 11 and beyond.

Applicants note that the Examiner’s outstanding Office Action classifies the Applicants’ arguments regarding claim 1 as “point A”; for example, in page 5 of the Office Action of August 21, 2007, the Examiner states:

With respect to claims 1, specifically, applicants contend that first, with respect to the teachings of Gough, there is a distinction that must be made between a “message” or “message content” and an email. The argument appears to be that Gough allegedly state a message to be a message content the[sic] is input by the sender. Applicants cherry

pick passages in the patent of Gough in order to present the reference in a light that is different from the claimed invention. The Examiner respectfully compels Applicants to capture the essence of the teachings of the prior art reference. (page 5, Office Action of 8/21/07)

Applicants respectfully submit that the Examiner has neglected to consider the other aspects of “point A”, which, as paraphrased by the Examiner on page 3 of the outstanding office action, included:

Applicants respectfully submit that, while Claim 1 recites the directing of an e-mail message AFTER origination by the originating user onto an e-mail enhancement path, the cited passages of Gough teach the generation of the email message with enhanced content attached thereto at the same site. (page 5, Office Action of 8/21/07)

That is, while it appears that the Examiner responded specifically a first portion of the Applicants’ previously submitted arguments regarding claim 1 (see pages 3 – 4 of the Amendment filed 5/25/07), the Examiner may not have considered other portions of the Applicants’ submitted arguments (see pages 4 – 5 of the Amendment filed 5/25/07). Also, the Examiner additionally states:

In the abstract of Dough[sic], “an e-mail message generated by the sender” is disclosed, not an email content as mischaracterized by applicants. The email message here is an email communication with all required portion of a complete message.

Applicants are unable to find this specific quoted passage in the published patent of Gough. Furthermore, this passage appears to be a singular interpretation or extension by the Examiner, as Applicants are unable to find the quoted language in the abstract of Gough. While the abstract does discuss an email message that is “to be” sent, Applicants are unable to find anything in the abstract which reasonably suggests that the email message is enhanced after it is sent.

As an attempt at further clarification of the recited limitations, claim 1 of the present application is amended herein to specify that the “origination” event involves composition and sending of the e-mail message by a standard messaging protocol. It is respectfully submitted that, in the cited passages or in whole, the art of record fails to teach the *addition of rich media content after the e-mail message has been composed and sent via a standard messaging protocol*, as recited in the amended claim 1. In fact, it is noted that an e-mail message enhancement scheme based on a web-based e-mail client, very much similar to that of Gough, is clearly shown and described by Applicants in reference to FIG. 2 and associated texts in the present application (e.g., paragraphs [0021] – [0026]) as prior art over which the limitations as recited in amended claim 1 is clearly distinct.

For at least the forgoing reasons, it is respectfully submitted that Gough does not teach each and every element of claim 1, as amended. Accordingly, reconsideration and withdrawal of the rejection of claim 1 under section 102(e) based on Gough is respectfully requested.

Claims 3, 4, 6 – 13 and 27 – 30 each depends directly or indirectly from claim 1 and, therefore, benefit from the same arguments presented above regarding claim 1 in light of the art of record. For at least this reason, it is respectfully submitted that each of these claims is also patentable over the art of record for at least the reasons set forth above with respect to claim 1. Further, each of these dependent claims places additional limitations on their parent and intermediate claims which, when considered in light of claim 1, further distinguish the claimed invention from the art of record.

For example, claims 3 and 12 provide that receiving the e-mail message at the first server includes TCP/IP socket communication. The Examiner again relies on the previously cited passage at column 3, lines 50-67, without further elaborating on how this particular cited passage teaches the use TCP/IP socket communication after the e-mail message has been composed and sent via a standard messaging protocol by an originating user of the first user group. It is again respectfully submitted that, while the cited passage mentions “the well-know[sic] TCP/IP packet network protocols”, it merely refers to protocols such as SMTP, POP and IMAP that are used in standard network architecture for e-mail delivery; that is, the cited passage does not disclose TCP/IP socket communication, as required in claims 3 and 12, which is a network protocol that enables communication between a standard e-mail server and the e-mail enhancement path, as described in detail in the present application. Therefore, it is respectfully submitted that the art of record does not anticipate the limitations as recited in claims 3 and 12.

As another example, claim 4 provides that receiving the e-mail message at the first server, after the e-mail message has been composed and sent via a standard messaging protocol by an originating user of the first user group, “includes using direct API access.” The Examiner again relies on FIG. 11 and column 14, lines 38-45 of Gough, without further elaboration as providing disclosure to this matter. Once more, Applicants respectfully point out that the cited figure and passage refers only once to an “API” in the description of step 1112 “ATTACH MESSAGE DATA”, where “the string and appendages, or message data, is attached to a message object (i.e., e-mail message) using the JAVA mail API”; that is, the cited passage concerns the use of a known application program interface available from Sun Microsystems for message delivery. In contrast, as clearly described in, for example, paragraph [0112] and FIG. 13 of the present application, the “direct API access” of claim 4 refers to capture of an email message from a conventional message delivery route to an enhancement path. Applicants respectfully submit the art of record, in the cited passage or in whole, does not support the same teaching as recited in claim 4. Therefore, it is respectfully submitted that the art of record does not anticipate the limitations as recited in claim 4.

As another example, again without further elaboration, the Examiner repeats his reliance on FIG. 3 item 36 of Gough as teaching the variety of limitations recited by all of claims 6 – 11. Again, it is unclear to Applicants how the cited portion of Gough teaches separation and modifying the header section in the way that is described in the present application; the Examiner's clarification is respectfully requested regarding this matter. In particular, item 36, FIG. 3, is described in Gough as "a header 36 with sender, recipient, and 'Re' information" without any teachings to any specific *modification* of header 36. Applicants respectfully submit that Gough, in the cited passage or in whole, is devoid of any teaching to the variety of modifications to the header section as recited in pending claims 6 – 11 of the present application. Moreover, it should be appreciated that this alteration of the header section, as recited in claims 6 – 11 of the present application, takes place after the e-mail has been composed and sent via a standard messaging protocol by the originating user. Therefore, it is respectfully submitted that the art of record does not anticipate the limitations as recited in claims 6 – 11.

As still another example, claim 13 recites

... wherein said directing the email message onto the e-mail enhancement path includes adding a request for additional rich media content to the e-mail message.

The Examiner relies on Gough at FIG. 2B and column 6, line 12-39 as assertedly providing this teaching. Applicants respectfully submit that FIG. 2B and associated passage simply describes an exemplary web page layout of a member sign up screen; that is, there is no teaching, in the cited passage or in Gough as a whole, to the addition of a request for additional rich media content to the e-mail message after the e-mail has been composed and sent via a standard messaging protocol by the originating user, as recited in claim 13 of the present application. Specifics of such a request or addition of tags specifying the desired e-mail enhancement, is clearly taught in, for example, paragraphs [0164], [0171] and [0172] of the present application as filed. Accordingly, allowance of claim 13 is respectfully requested for at least this reason. In the absence of such allowance, the Examiner's clarification is requested as to how the cited portions of Gough teaches such addition of a request for additional rich media content to the e-mail message, after the e-mail has been composed and sent via a standard messaging protocol by the originating user, as recited in claim 13 of the present application.

Claim 14, as amended, is an independent claim including limitations that reflect certain limitations of claim 1, as discussed above. For example, like amended claim 1, amended claim 14 recites limitations of, after the e-mail has been composed and sent via a standard messaging protocol by the originating user of the first user group, directing the e-mail message onto an e-mail enhancement path and adding additional rich media content to the e-mail message using the e-mail enhancement path to produce an enhanced e-mail message. Therefore, it is respectfully submitted that the arguments presented above in relation to these

certain limitations and regarding the allowability of amended claim 1 over Gough are also applicable to amended claim 14. Furthermore, amended claim 14 additionally recites providing a validation of the request such that the additional rich media content is added to the e-mail message responsive to the validation. The Examiner relies, again without elaboration, on the previously cited passages of FIG. 3, column 7, lines 43-61 and column 3, lines 50-67 of Gough for teachings of the limitations recited in claim 14. It is still unclear to the Applicants how these cited passages, or Gough as a whole, teach the *addition of a request or the validation of such a* amended request before including additional rich media content in an enhanced email message, and the Examiner's clarification is respectfully requested. For at least these reasons, Applicants respectfully submit that amended claim 14 overcomes the art of record.

Each of Claims 15-24 depends either directly or indirectly from and therefore includes the limitations of Claim 14. Accordingly, it is respectfully submitted that each of these claims is also patentable over the art of record for at least the reasons set forth above with respect to Claim 14. Further, each of these dependent claims places additional limitations on their parent and intermediate claims which, when considered in light of Claim 14, further distinguish the claimed limitations from the art of record.

For example, claim 17 provides for adding a message ID tag for identifying the e-mail message, which message ID tag is unique to that e-mail message. The Examiner relies, without elaboration, on column 14, lines 15-36 of Gough for teachings of this limitation. Applicants respectfully disagree and submit that the cited passage is merely a listing of exemplary HTML code (or HTML "tags") that may be appended to the message text provided by a sender. While Gough states that such parameters "may be used to identify the letter, expression, word, phrase, pattern, format, etc.", these parameters are clearly not the same as the message identification tags for use as recited in claim 17. For example, as clearly stated in paragraph [0085] of the present application, a tag in the context of the present application refers to information to permit a subsequent external enhancement server process to add desired rich media content that may have been added by a user plug-in. Applicants respectfully submit that such use of tags is not taught by Gough in the cited passage or in whole. For at least these reasons, it is respectfully submitted that claim 17 overcomes the art of record.

As another example, the Examiner again relies, without further elaboration, on the teachings of column 14, lines 15-36 of Gough to assert that the limitations recited in claims 15 and 17-24 are anticipated by Gough. These claims of the present application specifically recite limitations regarding inserting one or more reference tags into the e-mail message for use in the aforementioned validation limitation of claim 14, ranging from adding a group ID tag, adding a template ID tag, controlling such additions at an administrative level and determining where, in relation to the header, such tags may be added. It is still unclear to Applicants how the teachings of column 14, lines 15-36 of Gough are applicable to the variety of limitations recited in claims 15 and 17-24; that is, the cited material of Gough appears to be irrelevant to the limitations at



hand when viewed in a reasonable light. As stated above in reference to Claim 14, the cited passage does not teach, disclose nor suggest in any way the validation of a request for additional rich media content and, moreover, does not teach how such validation may be performed using reference tags, as recited in claims 15 and 17-24. Should the Examiner disagree with the Applicants' statement, further clarification regarding the applicability of the cited passage with respect to the teachings in the pending claims is respectfully requested.

Claim 25 is an independent claim including certain limitations and amendments similar to those of amended claim 1, as discussed above. For example, like amended claim 1, amended claim 25 provides, after the e-mail message has been composed and sent via a standard messaging protocol by an originating user of the first user group, directing the e-mail message onto an e-mail enhancement path and adding additional rich media content to the e-mail message to produce an enhanced e-mail message. Therefore, it is respectfully submitted that the arguments presented above relating to these certain limitations and regarding the allowability of amended claim 1 over Gough are also applicable to amended claim 25. Claim 25, as amended, additionally recites the use of an outgoing message path that includes at least one different process as compared to the incoming e-mail message path. The Examiner relies on teachings in column 18, lines 3-20 and column 4, lines 1-21 of Gough for this limitation in claim 25. Applicants respectfully submit that Gough, in the cited passages, does not disclose, teach or reasonably suggest in any way that an inbound message may be received by a sender at a sender machine 12, FIG. 1 of Gough. In contrast, claim 25 specifically provides separate paths for inbound and outbound e-mail messages, enhanced or other wise, to be received and sent by a user. For at least this reason, Applicants respectfully submit that claim 25 overcomes the art of record.

Claim 26 depends directly from and therefore includes the limitations of claim 25. Accordingly, it is respectfully submitted that claim 26 is also patentable over the art of record for at least the reasons set forth above with respect to claim 25. Furthermore, claim 26 additionally recites that routing the e-mail message to an out-going message path includes directing the e-mail message through a second server, which second server is outside of the in-coming e-mail message path. While the Examiner repeats his reliance upon FIG. 1, items 12 and 15 in Gough for teachings to the limitations as claimed in claim 26, items 12 and 15 of Gough refer to a sender and an e-mail server, respectively. It is respectfully submitted that Gough shows only an out-going e-mail message path and, therefore, does not teach an in-coming e-mail message path in the cited figure. For at least these reasons, Applicants respectfully submit that the art of record does not teach the limitations as recited in amended claim 26.

Amended claim 62 is an independent claim including limitations that reflect certain limitations recited in claim 1, as discussed above. For example, like claim 1, claim 62 provides directing the e-mail message to a predetermined location after the e-mail message has been originated by an originating user of the first user group and adding additional rich media content to the e-mail message to produce an enhanced e-mail message. Therefore, it is respectfully submitted that the arguments presented above in relation to these

certain limitations and regarding the allowability of amended claim 1 over Gough are also applicable to amended claim 62.

In addition to the cited passages previously discussed in reference to amended claim 1, the Examiner relies on the teachings in FIGS. 4 and 8, with an observation that “any number of instructions can be used in directing the message” (p. 15, Office Action of 8/21/07), for the third instructions for directing the enhanced e-mail message to the intended recipient. While Applicants had earlier expressed that it is unclear to Applicants how the teachings in FIGS. 4 and 8 relate to such instructions for directing the enhanced e-mail message to the intended recipient in combination with first instructions for directing the e-mail message to a predetermined location after the e-mail message has been originated by an originating user (see page 8 of the Amendment filed 5/25/07), the Examiner has simply repeated the same rejection of claim 62 without further clarification. Also, it is unclear to Applicants where the observation made by the Examiner regarding the number of instructions is supported in the art of record. Specifically referring to FIG. 4, as Gough states in column 8, lines 40-54, FIG. 4 is a “flowchart illustrating the execution of the first application program associated with the first electronic message that is sent to a first user”; that is, the flowchart in FIG. 4 refers to the HTML processes that take place when a sender 12, FIG.1, accesses website 11, FIG. 1, in order to generate an e-mail message. In contrast, claim 62 has been amended to clarify that first instructions direct the e-mail message to a predetermined location after the e-mail message has been composed and sent from a Mail Transport Agent (“MTA”) *via a standard messaging protocol*, not HTML. FIG. 8 is an illustration of a graphical user interface (GUI) associated with the execution of a “second application program,” which may include a “signed application program.” It is respectfully submitted that the Gough is vague as to exactly what is meant by the “first application program” and the “second application program”, much less how FIGS. 4 and 8 relate to the directing of an enhanced message to the intended recipient. While FIG. 8 appears to include a “destination” box 800 for insertion, by a user, of a destination address, Gough does not specify how such destination specification in the GUI would be implemented by software to direct an enhanced e-mail message to the specified destination. In contrast, the present application describes in detail ways in which header information in an e-mail message may be manipulated in order to intercept and modify an e-mail message originated by an originating user. Accordingly, it is believed that the reference fails to anticipate the limitations at hand. For at least these reasons, Applicants respectfully submit that claim 62 overcomes the art of record.

Claim 63 depends directly from claim 62 and, therefore, includes all of the limitations as recited in claim 62 such that the above arguments regarding claim 62 are also applicable to claim 63. Additionally, claim 63 includes a further limitation that the first, second and third instructions are distributed at least among the first user group and the first server. The Examiner again relies on FIGS. 4 and 8 of Gough, without further explanation, to provide the teachings to the limitations as recited in claim 63. It is unclear to Applicants how FIGS. 4 and 8 of Gough and their associated descriptions teach the distribution of first,

second and third instructions at least among the first user group and the first server. That is, as FIG. 4 of Gough provides only a flow chart corresponding to “a first application program” with no teaching of instructions for directing the e-mail message to a predetermined location, adding additional rich media content or directing the enhanced e-mail message to the intended recipient, and FIG. 8 is merely a screen shot of a GUI with no mention of servers or whether any of the contents of the process shown in FIG. 4 or the GUI of FIG. 8 may be distributed among different locations as taught in claim 63, it is respectfully submitted that claim 63 is not anticipated by the art of record.

Hence, it is respectfully submitted that all of remaining claims 1, 3, 4, 6 – 30 and 62 – 63 overcome the Examiner’s 35 U.S.C. §102(e) rejections over Gough. Therefore, Applicants respectfully request the passage of these claims to allowance.

#### **Claim Rejections – 35 U.S.C. 103(a)**

The Examiner rejected claims 43-61 and 64-72 under 35 U.S.C. 103(a) as being unpatentable over Gough in view of Shapiro et al. (Shapiro) U.S. Patent No. 6,965,926 B1.

The following is a quotation from the MPEP setting forth the three basic criteria that must be met to establish a *prima facie* case of obviousness:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. [MPEP §2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)]

Furthermore, a proposed modification cannot render the prior art unsatisfactory for its intended purpose:

If proposed modification would render the prior art unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. [MPEP 82143, citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)]

Under *In re Vaeck*, there must be: (a) some teaching or suggestion to modify the prior art, either in the reference or based on one of ordinary skill at the time the invention was made, without rendering the prior art unsatisfactory; (b) a reasonable expectation of success; and (c) all the claim elements must be taught. 947 F.2d 488, 20 USPQ2d 1438; see also *MPEP 2142* and *2143*. Under *In re Gordon*, a teaching or suggestion to modify the prior art must not render the prior art unsatisfactory for its intended purpose. 733 F.2d 900, 221 USPQ 1125; see also *MPEP 2143*.

Regarding claim 43, the Examiner states:

Gough discloses the invention substantially as claimed. Gough teaches in a multi-user e-mail messaging system interfaced through the Internet and including at least a first user group sharing at least a first server, which first server is, in turn, interfaced to the Internet such that any user of the first user group may send an email message for transfer to an intended recipient selected as at least one of (i) another user in the first user group and (ii) a remote user interfaced to the Internet by a connection other than said first server, said messaging system including a firewall surrounding said first user group and said first server (see Gough; fig. 1, items 10, 12, 14, 15, and 16; also see abstract), a method comprising:

after said email message has been originated by an originating user of the first user group, adding a request for desired additional rich media content to the e-mail message and placing the e-mail message en route to the intended recipient (column 18, lines 3-20; column 4, lines 1-21);

directing the e-mail message to a first location inside the firewall; at the first location, identifying the request for desired additional rich media content in the e-mail message and providing a validation of the request for desired additional rich media content (column 18, lines 3-20; column 4, lines 1-21; column 13, lines .18-26);

forwarding the e-mail message to a second location outside the firewall; at the second location, adding the desired additional rich media content to said e-mail message responsive to said validation to produce an enhanced e-mail message; and thereafter, redirecting the enhanced e-mail message to the intended recipient (figs. 1 and 3; column 7, lines 43-61; column 3, lines 50-67). However, Gough does not disclose the details of “directing the e-mail message to a first location inside the firewall and forwarding the e-mail message to a second location outside the firewall. [Office Action of 8/21/07, pp. 15-16]

With regard to these features, the Examiner asserts that,

In the same field of endeavor, Shapiro discloses a[sic] “Those skilled in the art will be familiar with configuring multiple computers to operate as a single server with farms of computers functioning as fire walls, database servers, proxy servers, and process load balancers... he[sic] dynamic content server may also be implemented to handle security protocols related to the content. Some of the content may be personal, confidential or proprietary. The dynamic content server (as well as the front-end client module 610 and the receiving email client module 670) may use custom or

commercially available security protocols that may be overlaid onto content streams as they exit the front-end node 405 and the dynamic content server 440 in order to provide a secure email environment. In the exemplary embodiment, a conventional triple DES security protocol is preferred to be overlaid on outgoing streams of content to provide secure messaging. Other security protocols may be used as well..."[see Shapiro; column 11, lines 46-54; column 20, lines 58-67].

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Shapiro's teachings of firewalls to secure an e-mail message, with the enhanced e-mail within an enhancement path teachings of Gough, for the purpose of [sic] "to provide a comprehensive solution for receiving and viewing content-rich communications and messages that enable efficient delivery of such messages while avoiding the need for large downloads and issues with latency..." as stated by Shapiro in lines 25-31 of column 3. By this rationale claim 43 is rejected. [Office Action of 8/21/07, pp. 16-17]

Applicants respectfully disagree with the above statements by the Examiner regarding the combination of the art of record, as will be discussed in detail immediately hereinafter.

As the Examiner has conceded, Gough does not disclose details of directing the e-mail message to a first location inside the firewall and forwarding the e-mail message to a second location outside the firewall. In fact, Gough is completely devoid of any teaching regarding firewalls and the term "firewall" does not appear anywhere in the entirety of Gough.

Particularly regarding the Applicants' previously presented arguments regarding the combination of Gough and Shapiro (i.e., "Point F" in the Office Action of 8/21/07, pages 4 and 6), the Examiner appears to misconstrue the Applicants' arguments, saying:

As to point F, the Examiner disagrees with Applicants as to the statement that the word firewall is not mentioned in the teachings of Shapiro. Shapiro discloses in column 11 that those skilled in the art will be familiar with configuring multiple computers to operate as a single server with farms of computers functioning as firewalls, database servers, proxy servers, and process load balancers. [Office Action of 8/21/07, page 6]

However, Applicants had instead stated that *Gough* is devoid of any teachings regarding the incorporation of a firewall into an e-mail message enhancement system:

Firstly, while the Examiner asserts, on page 12 of the outstanding Office Action, that Gough discloses “said messaging system including a firewall surrounding said first user group and said first server”, it is respectfully submitted that *Gough* is absent of any teachings related to firewalls. In fact, the term “firewall” does not appear in the entirety of *Gough*. [Amendment submitted on 5/25/07, page 9, emphasis added]

Furthermore, the only time the term “firewall” is used in Shapiro is at column 11, line 49, where it is mentioned in passing that “farms of computers” may function as firewalls. Any discussion of how a firewall relates to the creation and enhancement of previously created e-mail messages, as recited in amended claim 43 of the present application, is absent in Shapiro. Applicants respectfully submit that *mere mention* of the term firewall does not constitute a complete and enabling teaching of the limitations as claimed in amended claim 43 of the present application.

In other words, the lengthy passages from Shapiro cited by the Examiner in the outstanding Office Action (shown above) relate to essentially a laundry list of possible configurations of multiple computers and security protocols. In fact, there is no teaching in Shapiro to the performance of specific tasks related to the enhancement of e-mail messages (or any message generation related processes for that matter) at distinct locations with respect to a firewall. Although the Examiner asserts that the incorporation of “Shapiro’s teachings of firewalls to secure an e-mail message[,] with the enhanced e-mail within an enhancement path teachings of Gough, for the purpose of “to provide a comprehensive solution for receiving and viewing content-rich communications and messages that enable efficient delivery of such messages while avoiding the need for large downloads and issues with latency...” as stated by Shapiro in lines 25-31 of column 3” (page 17, Office Action of 8/17/07), Applicants respectfully submit that there is no teaching in either Gough or Shapiro to motivate the combination of an e-mail enhancement system, as claimed, with a firewall for any reason.

Moreover, amended claim 43 includes the limitation, “providing a validation of the request for desired additional rich media content,” which is not taught nor suggested anywhere in Gough or Shapiro separately or in reasonable combination. The Examiner relies on the previously cited passages of column 18, lines 3-20; column 4, lines 1-21 of Gough for teachings of this limitation. It is unclear to Applicants how these cited passages apply to the validation of the request for desired additional rich media content; particularly, column 18, lines 3-20 of Gough corresponds claim 21 of Gough, which does not mention “validation” anywhere therein, and column 4, lines 1-21 of Gough is a partial description of FIG. 1 of Gough, which also does not contain any teachings regarding the provision of a validation of the request for desired additional rich media content. Therefore, it is respectfully submitted that neither these cited passages nor Gough as a whole teach, disclose or reasonably suggest the addition of a request or the validation of such a request before including additional rich media content in an enhanced email message.

In contrast, the present application as filed discusses in detail the architectural flexibility of the disclosed e-mail messaging system to advantageously provide compatibility with a variety of firewall and security configurations (see, for example, paragraph [0173] of the application as filed). More specifically, amended claim 43 provides for validation of a request for additional rich media content at a first location inside a firewall and a subsequent addition of the desired additional rich media content at a second location outside of the firewall to produce an enhanced e-mail message. In other words, amended claim 43 provides for an e-mail enhancement path that is distinct from a standard e-mail messaging path and resides at a location distinct from the originating user as well as the mail servers. Such a configuration is described in detail in the present application as filed in, for example, FIG. 7 and associated paragraph [0082]. Therefore, Applicants respectfully submit that Gough and Shapiro, separately or in combination, do not teach the limitations as recited in amended claim 43.

Claim 44, as amended, is an independent claim including limitations that reflect certain limitations of amended claim 43, as discussed above. Therefore, it is respectfully submitted that the arguments presented above regarding the allowability of amended claim 43 over the combination of Gough and Shapiro are also applicable to amended claim 44. Furthermore, claim 44, as amended, includes additional limitations that further distinguish it from the combination of the art of record. For example, amended claim 44 additionally recites providing a validation of the request such that the additional rich media content is added to the e-mail message responsive to the validation; in particular, claim 44, as amended, includes the limitation:

at the first location, adding a request for desired additional rich media content to the e-mail message and providing a validation of the request for desired additional rich media content; forwarding the e-mail message to a second location outside the firewall.  
[claim 44, as amended]

The Examiner relies on the passage of Shapiro discussed above (i.e., column 11, lines 46-54; column 20, lines 58-67) to provide this limitation. It is respectfully submitted that Shapiro, alone or in combination with Gough and even if considered as a whole and beyond the cited passages, is devoid of any teaching regarding the addition of a request for additional rich media content to an e-mail message at any location, much less providing a validation of the request for desired additional rich media content at that location, or forwarding the e-mail message to a second location outside the firewall. As discussed above in relation to amended claim 43, Shapiro merely mentions in passing the term “firewall” once in the cited passages, and Gough and Shapiro, taken singly or in combination, does not teach nor suggest all of the limitations of amended claim 44. Therefore, Applicants respectfully submit that the combination of Gough and Shapiro does not teach, disclose or reasonably suggest the limitations as recited in amended claim 44.

Each of claims 45-61, 64, 66, 68, 70 and 72, as amended, is an independent claim including limitations which reflect certain limitations recited in amended claims 43 and 44, as discussed above. For example, each of amended claims 45-61, 64, 66, 68, 70 and 72 recites different processes related to enhanced e-mail message generation performed at distinct locations with respect to a firewall that surrounds a first user group and a first server. Therefore, it is respectfully submitted that the arguments presented above in relation to these certain limitations and regarding the allowability of amended claims 43 and 44 over the combination of Gough and Shapiro are also applicable to amended claims 45-61, 64, 66, 68, 70 and 72. For at least these reasons, Applicants respectfully submit that amended claims 45-61, 64, 66, 68, 70 and 72 overcome the art of record.

Claim 65 depends directly from amended claim 64 and, therefore, includes all of the limitations as recited in amended claim 64 such that the above arguments regarding claim 64, as amended, are also applicable to claim 65. Additionally, claim 65 includes a further limitation that a second server is located at a predetermined location (outside of the firewall) such that the first through sixth instructions are distributed among the first user group and the first server (surrounded by the firewall) and the second server. The Examiner again relies on FIG. 3, column 7, lines 43-61, and column 3, lines 50-67 of Gough, without elaboration, to allegedly provide the additional teachings to the limitations as recited in claim 65. However, Applications respectfully continue to maintain that the cited passages do not teach the addition of rich media content to an e-mail message, responsive to a validation of a request for desired additional rich media content, to produce an enhanced e-mail message AFTER the e-mail message has been composed and sent, using a standard messaging protocol, by an originating user, nor do they teach the distribution of the instructions for the producing the enhanced e-mail message at specific locations in relation to a firewall, as recited in amended claim 65. Therefore, it is respectfully submitted that claim 65, as amended, overcomes the art of record.

Claim 67 depends directly from amended claim 66 and, therefore, includes all of the limitations as recited in amended claim 66 such that the above arguments regarding amended claim 66 are also applicable to claim 67. Additionally, claim 67 includes a further limitation that the first through sixth instructions are distributed at least among the first user group and the first server. The Examiner again relies on column 18, lines 3-20 and column 4, lines 1-21 of Gough, without further clarification, to assertedly provide the additional teachings to the limitations as recited in claim 67. However, Applicants maintain that the cited passages do not teach the addition of rich media content to an e-mail message, responsive to a validation of a request for desired additional rich media content, to produce an enhanced e-mail message AFTER the e-mail message has been composed and sent using a standard messaging protocol by an originating user, nor do they teach distribution of the instructions for producing the enhanced e-mail message at specific locations in relation to a firewall, as recited in claim 67. Therefore, it is respectfully submitted that claim 67 overcomes the art of record.



Claim 69 depends directly from amended claim 68 and, therefore, includes all of the limitations as recited in amended claim 68 such that the above arguments regarding amended claim 68 are also applicable to claim 69. Additionally, claim 69 includes a further limitation that the predetermined location, at which the desired additional rich media content to the e-mail message is added responsive to a validation, is situated outside of a firewall surrounding the first user group and the first server. The Examiner again relies on column 18, lines 3-20 and column 4, lines 1-21 of Gough to provide the additional teachings to the limitations as recited in claim 69. However, Applicants respectfully maintain that the cited passages are absent of any teachings to distribution of e-mail processing with respect to a firewall. Therefore, it is respectfully submitted that claim 69 overcomes the art of record.

Claim 71 depends directly from amended claim 70 and, therefore, includes all of the limitations as recited in amended claim 70 such that the above arguments regarding the allowability of amended claim 70 are also applicable claim 71. Additionally, claim 71 includes a further limitation that the preprocessing means includes means for validating the reference tag according to a set of desired criteria after the e-mail message, including the reference tag, has been sent. The Examiner again relies on Gough at column 14, lines 15-36 for teachings regarding this limitation. However, as discussed previously, it is respectfully submitted that the passage cited merely a listing of exemplary HTML code (or HTML "tags") that may be appended to the message text provided by a sender. While Gough states that such parameters "may be used to identify the letter, expression, word, phrase, pattern, format, etc.", these parameters are clearly not the same as the message identification tags for use as recited in claim 71. For example, as clearly stated in paragraph [0085] of the present application, a tag in the context of the present application refers to information to permit a subsequent external enhancement server process to add desired rich media content that may have been added by a user plug-in. Furthermore, in the cited passage or when considered as a whole, Gough is devoid of any teaching regarding the validation of a reference tag. Applicants respectfully submit that such use and validation of tags is not taught by Gough in the cited passage or in whole and, therefore, for at least these reasons, it is respectfully submitted that claim 71 overcomes the combination of the art of record.

For all of the foregoing reasons, it is respectfully submitted that all of the Examiner's objections have been overcome and that the application is in condition for allowance. Hence, Applicants respectfully request allowance of the claims under immediate consideration, and passage to issue of the application is solicited.

Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the Examiner is requested to contact the undersigned at 303-410-9254.

Respectfully submitted,  
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